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| 10/614,048      | 07/08/2003  | Kazuto Yamamoto      | 011350-313          | 7566             |

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| EXAMINER |
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POPOVICI, DOV

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2625

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| MAIL DATE | DELIVERY MODE |
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11/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/614,048

Applicant(s)

YAMAMOTO, KAZUTO

Examiner

Dov Popovici

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/8/2003; 8/6/2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

*Dov Popovici*  
DOV POPOVICI  
PRIMARY EXAMINER  
ART UNIT 2625

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because (1) it contains two paragraphs (The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words), and (2) it contains legal phraseology, such as "said" (see page 72, line 8). Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

Claim 2 is objected to because of the following informalities:

In claim 2, line 4, "for" (second occurrence) should be --of--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 26-36 are claiming a program per se. Claims 26-36 are directed to non-statutory functional descriptive material. "Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. " " Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as

nonstatutory functional descriptive material” (see Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Takayama (US 2002/0140986)

The applied reference has a common assignee with the instant application.  
Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to claim 1, Takayama discloses an image processing device comprising:  
an e-mail receiving means (mail server MS; see figures 4 and 8) for receiving first e-mail (ML1) transmitted with an attachment file (D) but deprived of said attachment file due to a capacity limit of a relaying mail server; an e-mail transmitting means (mail server MS,

see figures 4 and 8) for transmitting second e-mail (ML2), which contains information of its own online location and a transfer request for transferring said attachment file, to the transmission source and other transmission destinations of said first e-mail (ML1) in response to receiving of said first e-mail; an attachment file receiving means (SV see figure 8 or 231 see figure 4) for receiving said attachment file (D) transmitted in response to said second e-mail from equipment pertaining to the transmission source or another transmission destination of said first e-mail; and an image forming means (see figure 1) for forming images of said attachment file in response to receiving of said attachment file.

As to claim 2, Takayama discloses an image processing device comprising: a first e-mail receiving means (mail server MS; see figures 4 and 8) for receiving first e-mail (ML1) having an attachment file (D); an image forming means (1) for forming images for said attachment file; a second e-mail receiving means (90) for receiving second e-mail (ML2), which contains online location information of equipment pertaining to another transmission destination of said first e-mail and a transfer request for transferring said attachment file, from said another transmission destination; and an attachment file transferring means (TP) for transferring said attachment file to equipment pertaining to said another transmission destination in response to receiving of said second e-mail, when it is possible to access said equipment pertaining to said another transmission destination based on the online location information of said equipment pertaining to said another transmission destination (see figures 1, 4, 6 and 8).

As to claim 3, Takayama discloses an image processing device comprising:  
  
an e-mail transmitting means (MFP 1) for transmitting first e-mail (ML1) having an attachment file (D); an e-mail receiving means (90 for receiving second e-mail (ML2) containing online location information of equipment (TP) pertaining to transmission destination of said first e-mail and a transfer request for transferring said attachment file, from said transmission destination; and an attachment file transferring means (TP) for transferring said attachment file to said equipment pertaining to said transmission destination (90) in response to receiving of said second e-mail, when it is possible to access said equipment pertaining to said transmission destination based on online location information of said equipment pertaining to said transmission destination.

As to claim 4, Takayama discloses further comprising: an e-mail retransmitting means (31 and SV and 231 and 90) for retransmitting said first e-mail deprived of said attachment file to said transmission destination (90) of said first e-mail, when said first e-mail cannot be delivered to said transmission destination due to a relaying mail server's capacity limitation.

As to claim 5, Takayama discloses further comprising: an image reading device (13) for acquiring image data by reading an image; wherein said attachment file is the image data acquired by said image reading device (13).

As to claim 6, Takayama discloses an image processing device comprising: a first e-mail receiving means (MAIL SERVER MS) for receiving first e-mail (ML1) transmitted with an attachment file (D) but deprived of said attachment file due to a

capacity limit of a relaying mail server; an e-mail transmitting means (MS) for transmitting second e-mail (ME) containing a response request for responding online location information of equipment pertaining to the transmission source or other transmission destinations to said transmission source and said other transmission destinations in response to receiving of said first e-mail (ML1); a second e-mail receiving means (90) for receiving third e-mail (ML2), which contains online location information of equipment pertaining to said transmission source or another transmission destination of said first e-mail, transmitted from said transmission source or said another transmission destination in accordance with said second e-mail; a transfer request transmitting means (TP) for transmitting a transfer request for transferring said attachment file to equipment pertaining to said transmission source or said another transmission destination in response to receiving of said third e-mail (ML2), when it is possible to access to said equipment pertaining to said transmission source or said another transmission destination based on online location information of equipment pertaining to said transmission source or said another transmission destination; an attachment file receiving means (90) for receiving said attachment file transmitted from said transmission source or said another transmission destination in response to said transfer request; and an image forming means (1) for forming images of said attachment file in response to the receiving by said attachment file receiving means.

As to claim 7, Takayama discloses an image processing device comprising: a first e-mail receiving means (MS) for receiving e-mail having an attachment file (D); an image forming means (1) for forming images for said attachment file; a second e-mail



receiving means (ME) for receiving second e-mail containing a response request for responding its own online location information from another transmission destination of said first e-mail; an e-mail transmission means (MS) for transmitting third e-mail (ML2) containing its own online location information to said another transmission destination in response to receiving of said second e-mail; a transfer request receiving means (AR4) for receiving a transfer request for transferring said attachment file transmitted in response to said third e-mail (ML2) by equipment pertaining to said another transmission destination; and an attachment file transfer means (AR5, TP) for transmitting said attachment file to equipment pertaining to said another transmission destination in response to said transfer request.

As to claims 8-36, these claims recite the same and/or similar claim limitations as claimed in claims 1-7 above, and therefore claims 8-36 are rejected as similarly as claims 1-7 above. Applicant is directed to the remarks and the discussion made above with respect to claims 1-7.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-9, 11-29, 31-34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirani et al. (U.S. 2002/0016818).

As to claim 11, Kirani et al. discloses a mail server (see figure 3) comprising: an e-mail receiving means for receiving e-mail having an attachment file; and an e-mail delivery means for delivering said e-mail deprived of said attachment file to the transmission destination of said e-mail when volume of said e-mail exceeds a specified capacity limit (see paragraphs 0036, 0037 and 0064).

As to claim 18, Kirani et al. discloses a mail server (see figure 3) comprising: an e-mail receiving part for receiving e-mail having an attachment file; and an e-mail delivery part for delivering said e-mail deprived of said attachment file to the transmission destination of said e-mail when volume of said e-mail exceeds a specified capacity limit (see paragraphs 0036, 0037 and 0064).

As to claim 25, Kirani et al. discloses an e-mail delivery method comprising: a step of receiving e-mail having an attachment file; and a step of delivering said e-mail deprived of said attachment file to the transmission destination of said e-mail when volume of said e-mail exceeds a specified capacity limit (see paragraphs 0036, 0037 and 0064).

As to claim 36, Kirani et al. discloses an e-mail delivery program for causing an e-mail server (see figure 3) to execute: a step of receiving e-mail having an attachment file; and a step of delivering said e-mail deprived of said attachment file to the transmission destination of said e-mail when volume of said e-mail exceeds a specified capacity limit (see paragraphs 0036, 0037 and 0064).

As to claim 1, Kirani et al. discloses an image processing device comprising: an e-mail receiving means (see figure 3) for receiving first e-mail transmitted with an attachment file but deprived of said attachment file due to a capacity limit of a relaying mail server; an e-mail transmitting means for transmitting second e-mail (modified e-mail which includes i.e. URL link, see paragraph 0064), which contains information of its own online location and a transfer request for transferring said attachment file, to the transmission source and other transmission destinations of said first e-mail in response to receiving of said first e-mail; an attachment file receiving means (325) for receiving said attachment file transmitted in response to said second e-mail from equipment pertaining to the transmission source or another transmission destination of said first e-mail, and an image forming means (see figure 1, printer 107) for forming images of said attachment file in response to receiving of said attachment file (see paragraphs 0036, 0037 and 0064).

As to claim 2, Kirani et al. discloses an image processing device comprising: a first e-mail receiving means (see figure 3) for receiving first e-mail having an attachment file; an image forming means (see figure 1, printer 107) for forming images of said attachment file; a second e-mail receiving means (350) for receiving second e-mail, which contains online location information (i.e., a URL link) of equipment pertaining to another transmission destination of said first e-mail and a transfer request for transferring said attachment file, from said another transmission destination; and an attachment file transferring means (335) for transferring said attachment file to equipment pertaining to said another transmission destination in response to receiving

of said second e-mail, when it is possible to access said equipment pertaining to said another transmission destination based on the online location information of said equipment pertaining to said another transmission destination (see paragraphs 0036, 0037 and 0064).

As to claim 3, Kirani et al. discloses an image processing device comprising: an e-mail transmitting means (see figure 3) for transmitting first e-mail having an attachment file; an e-mail receiving means (350) for receiving second e-mail containing online location information of equipment pertaining to transmission destination of said first e-mail and a transfer request for transferring said attachment file, from said transmission destination; and an attachment file transferring means (335) for transferring said attachment file to said equipment pertaining to said transmission destination in response to receiving of said second e-mail, when it is possible to access said equipment pertaining to said transmission destination based on online location information of said equipment pertaining to said transmission destination.

As to claim 4, Kirani et al. discloses further comprising: an e-mail retransmitting means (315) for retransmitting said first e-mail deprived of said attachment file to said transmission destination (350) of said first e-mail, when said first e-mail cannot be delivered to said transmission destination due to a relaying mail server's capacity limitation.

As to claim 6, Kirani et al. discloses an image processing device comprising: a first e-mail receiving means (315, see figure 3) for receiving first e-mail transmitted with

an attachment file but deprived of said attachment file due to a capacity limit of a relaying mail server; an e-mail transmitting means (315) for transmitting second e-mail (reads on: sending the attached file to server 335) containing a response request for responding online location information of equipment pertaining to the transmission source or other transmission destinations to said transmission source and said other transmission destinations in response to receiving of said first e-mail; a second e-mail receiving means (350) for receiving third e-mail (reads on: the modified e-mail) which contains online location information (i.e., URL link) of equipment pertaining to said transmission source or another transmission destination of said first e-mail, transmitted from said transmission source (300) or said another transmission destination (325 and 335) in accordance with said second e-mail; a transfer request transmitting means (350) for transmitting a transfer request for transferring said attachment file to equipment pertaining to said transmission source or said another transmission destination in response to receiving of said third e-mail, when it is possible to access to said equipment pertaining to said transmission source or said another transmission destination based on online location information of equipment pertaining to said transmission source or said another transmission destination; an attachment file receiving means (350) for receiving said attachment file transmitted from said transmission source or said another transmission destination in response to said transfer request; and an image forming means (see figure 1, printer 107) for forming images of said attachment file in response to the receiving by said attachment file receiving means.

As to claim 7, Takayama discloses an image processing device comprising: a first e-mail receiving means (315, see figure 3) for receiving e-mail having an attachment file; an image forming means (see figure 1, printer 107) for forming images for said attachment file; a second e-mail receiving means (335) for receiving second e-mail containing a response request for responding its own online location information from another transmission destination of said first e-mail; an e-mail transmission means (315) for transmitting third e-mail (reads on the modified e-mail) containing its own online location information (i.e., URL link) to said another transmission destination (335) in response to receiving of said second e-mail; a transfer request receiving means (335) for receiving a transfer request for transferring said attachment file transmitted in response to said third e-mail by equipment pertaining to said another transmission destination; and an attachment file transfer means (335) for transmitting said attachment file to equipment pertaining to said another transmission destination in response to said transfer request.

As to claims 8-9, 12-17, 19-24, 26-29 and 31-34, these claims recite the same and/or similar claim limitations as claimed in claims 1-4 and 6-7 above. Therefore, claims 8-9, 12-17, 19-24, 26-29 and 31-34 are rejected as similarly as claims 1-4 and 6-7 above. Applicant is directed to the remarks and the discussion made above with respect to claims 1-4 and 6-7.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 10, 30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani et al. (U.S. 2002/0016818).

As to claims 5, 10, 30 and 35, Kirani et al. does not teach an image reading device for acquiring image data by reading an image; wherein said attachment file is the image data acquired by said image reading device.

The examiner is taking Official Notice that an image reading device (such as a scanner) for acquiring or scanning image data by reading an image; wherein said attachment file is the image data acquired by said image reading device, is well known the computer technology.

Therefore, it would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Kirani et al. system by providing an image reading device (i.e., such as a scanner) for acquiring image data by reading an image; wherein said attachment file is the image data acquired by said image reading device.

It would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Kirani et al. so that the user can scan images or documents and attach these images and/or documents to an e-mail message as an attachment(s) so that the user can send scanned images/documents to other locations and users via e-mail.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Marchionda (U.S. 6,628,306) teaches e-mail applications option to cc: secondary recipients without attachments.

Hilbert et al. (U.S. 2005/0188026) teaches intercept email messages with attachments, transmit attachments to file server, and a parser removes the attachments and inserts links.

Nishiyama (JP 2000235529) teaches when a file of a size exceeding the previously determined reference value is attached to an email to be transmitted, the email is transmitted without annexing the file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dov Popovici  
Primary Examiner  
Art Unit 2625